UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _10 November 2008_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-28_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-28_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _1/17/08_.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. This **Non-Final** action is responsive to the Appeal Brief filed 11/10/2008 (note: prosecution has been reopened) and

IDS filed on 1/17/2008.

2. Claims 1-28 remain pending. Claims 1, 6, 11, 13, 18, 23 and 26 are the independent claims.

Withdrawn Rejections

3. The 35 U.S.C. 103(a) rejections of claims 1, 4-7, 10-11, 13, 16-19, 22-23 and 25-27 with cited references of Kondo

(U.S. 5,713,021) in view of Kanevsky (U.S. 7,075,671) has been withdrawn in light of the new grounds of rejection.

4. The 35 U.S.C. 103(a) rejections of claims 2-3, 8-9, 12, 14-15, 20-21, 24 and 28 with cited references of Kondo (U.S.

5,713,021) in view of Kanevsky (U.S. 7,075,671) further in view of Orr (U.S. 6,430,357) has been withdrawn in light of the new

grounds of rejection.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 1/17/2008 has been entered, and considered by the examiner.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new
> and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

> The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a
> "useful, concrete and tangible result." **>*State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d
> 1368, 1373-74, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998).< The purpose of this requirement is to limit patent
> protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents
> nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v.
> Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96 (1966); *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed.
> Cir. 2005); *In re Ziegler*, 992 F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)).

Claims 11-12 are rejected under 35 U.S.C. 101, the claim describes "a paper document comprising:", the document

itself however is considered to be non-functional descriptive material since the paper itself contains a compilation or arrangement

of mere facts or data without any functional interrelationship and therefore fails to be a process, machine, manufacture or

composition of matter, therefore the claim is non-statutory.

Claims 13-17 and 18-22 are rejected under 35 U.S.C. 101, the claims describe a "System", the claim fails to include a hardware element such as a CPU in the system or a computer readable medium for a software system. The claim is not statutory since the system itself only describes a series of abstract steps with no device for implementation or storage for any practical application.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8.   Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown (U.S. 6,665,838, filed on Jul 30, 1999).

Regarding Independent claims 1, 13 and 23, A computer-implemented method of generating a paper document based upon a plurality of multimedia documents storing multimedia information in electronic form, the method comprising: receiving input identifying a selection criterion; analyzing the multimedia information stored by the plurality of multimedia documents in response to the input to identify portions of multimedia information that satisfy the selection criterion, the portions of multimedia information including at least a first portion extracted from a first multimedia document from the plurality of multimedia documents and a second portion extracted from a second multimedia document from the plurality of multimedia documents; and printing the portions of the multimedia information that satisfy the selection criterion, including the extracted first portion and the extracted second portion, on a paper medium to generate the paper document comprising a set of one or more printed pages.

Brown discloses receiving input identifying a selection criterion defined by a user (see abstract & fig 8 & column 2, lines 23-42). He goes on to teach analyzing multimedia information from a plurality of multimedia documents based on the user query that includes a first portion from a first multimedia document shown in fig 10 with a thumbnail and portion of textual excerpt identified as 1, He teaches a second portion extracted from a second document from the plurality of multimedia documents identified as 2. Brown further provides a suggestion for printing the first and second consolidated portions because he discloses that "These clients may print to printer 216..." (see column 3, lines 50-60).

Regarding Dependent claims 2 and 14, Brown discloses wherein printing the portions of the multimedia information that satisfy the selection criterion on the paper medium to generate the paper document comprises: printing text information on at least one page of the set of printed pages of the paper document such that words in the text information that satisfy the selection criterion are annotated, wherein the text information is extracted from the portions of the multimedia information (see abstract & fig 8 & column 2, lines 23-42, including the explanation provided in the Independent claim).

Regarding Dependent claims 3 and 15, Brown discloses wherein printing the portions of the multimedia information that satisfy the selection criterion on the paper medium to generate the paper document comprises: printing one or more video frames on at least one page of the set of printed pages of the paper document such that at least one video frame that satisfies the selection criterion is annotated, wherein the one or more video frames are extracted from the portions of the multimedia information (see abstract & fig 8 & column 2, lines 23-42, including the explanation provided in the Independent claim).

Regarding Dependent claims 4, 10, 16 and 22, Brown discloses wherein receiving input identifying the selection criterion comprises: receiving information identifying a topic of interest (see abstract & fig 8 & column 2, lines 23-42, including the explanation provided in the Independent claim).

Regarding Dependent claims 5, 17 and 25, Brown discloses wherein printing the portions of the multimedia information that satisfy the selection criterion on the paper medium to generate the paper document comprises: generating a printable representation for the portions of the multimedia information that satisfy the selection criterion; and printing the printable representation on the paper medium to generate the paper document (see abstract & fig 8 & column 2, lines 23-42, including the explanation provided in the Independent claim).

Regarding Independent claims 6, 18 and 26, A method of generating a paper document using multimedia information stored by a first multimedia document and a second multimedia document, the method comprising: receiving input identifying a selection criterion; accessing printable representations for the first multimedia document and the second multimedia document; analyzing the printable representation for the first multimedia document in response to the input to identify at least one portion of the printable representation that satisfies the selection criterion;

analyzing the printable representation for the second multimedia document in response to the input to identify at least one portion of the printable representation that satisfies the selection criterion; generating a consolidated printable representation that includes the at least one portion of the printable representation for the first multimedia document and the at least one portion for the second multimedia document that satisfy the selection criterion; and printing the consolidated printable representation on a paper medium to generate the paper document comprising one or more printed pages.

Brown discloses receiving input identifying a selection criterion defined by a user (see abstract & fig 8 & column 2, lines 23-42). He goes on to teach analyzing multimedia information from a plurality of multimedia documents based on the user query that includes a first portion from a first multimedia document shown in fig 10 with a thumbnail and portion of textual excerpt identified as 1, He teaches a second portion extracted from a second document from the plurality of multimedia documents identified as 2. Brown further provides a suggestion for printing the first and second consolidated portions because he discloses that "These clients may print to printer 216..." (see column 3, lines 50-60).

Regarding Dependent claims 7, 19 and 27, Brown discloses wherein: analyzing the printable representation for the first multimedia document comprises determining at least one page in the printable representation for the first multimedia document that comprises information that satisfies the selection criterion; analyzing the printable representation for the second multimedia document comprises determining at least one page in the printable representation for the second multimedia document that comprises information that satisfies the selection criterion; and generating the consolidated printable representation comprises including the at least one page from the printable representation for the first multimedia document and the at least one page from the printable representation for the second multimedia document in the consolidated printable representation (see abstract & fig 8 & column 2, lines 23-42, including the explanation provided in the Independent claim).

Regarding Dependent claims 8 and 20, Brown discloses wherein printing the consolidated printable representation on the paper medium to generate the paper document comprises: printing text information on at least one page of the one or more printed pages of the paper document such that words in the text information that satisfy the selection criterion are annotated (see abstract & fig 8 & column 2, lines 23-42, including the explanation provided in the Independent claim).

Regarding Dependent claims 9 and 21, Brown discloses wherein printing the consolidated printable representation on the paper medium to generate the paper document comprises: printing one or more video frames on at least one page of the one or more printed pages of the paper document such that at least one video frame of the one or more video frames that satisfies the selection criterion is annotated (see abstract & fig 8 & column 2, lines 23-42, including the explanation provided in the Independent claim).

Regarding Independent claim 11, A paper document that comprises: one or more pages, wherein at least one page of the one or more pages is imprinted with text information that is extracted from multimedia information stored by a plurality of multimedia documents if the text information satisfies a selection criterion, the multimedia information analyzed in response input that identifies the selection criterion, and wherein the at least one page is imprinted with one or more video frames corresponding to the text information extracted from the plurality of multimedia documents.

Brown discloses receiving input identifying a selection criterion defined by a user (see abstract & fig 8 & column 2, lines 23-42). He goes on to teach analyzing multimedia information from a plurality of multimedia documents based on the user query that includes a first portion from a first multimedia document shown in fig 10 with a thumbnail and portion of textual excerpt identified as 1, He teaches a second portion extracted from a second document from the plurality of multimedia documents identified as 2. Brown further provides a suggestion for printing the first and second consolidated portions because he discloses that "These clients may print to printer 216…" (see column 3, lines 50-60).

Regarding Dependent claim 12, with dependency of claim 11, Brown discloses wherein the text information is extracted from closed-caption text information or audio information included in the multimedia information stored by the plurality of multimedia documents and the one or more video frames are extracted from video information included in the multimedia information stored by the plurality of documents (see abstract & fig 8 & column 2, lines 23-42, including the explanation provided in the Independent claim).

Regarding Dependent claim 24, with dependency of claim 23, Brown discloses wherein the code for printing the portions of the multimedia information that satisfy the selection criterion on the paper medium to generate the paper document comprises: code for printing text information on at least one page of the set of printed pages of the paper document such that words in the text information that satisfy the selection criterion are annotated, wherein the text information is extracted from the portions of the multimedia information; and code for printing one or more video

frames on the at least one page such that at least one video frame that satisfies the selection criterion is annotated, wherein the one or more video frames are extracted from the portions of the multimedia information (see abstract & fig 8 & column 2, lines 23-42, including the explanation provided in the Independent claim).

Regarding Dependent claim 28, with dependency of claim 26, Brown discloses wherein the code for printing the consolidated printable representation on the paper medium to generate the paper document comprises: code for printing text information on at least one page of the one or more printed pages of the paper document such that words in the text information that satisfy the selection criterion are annotated; and code for printing one or more video frames on at least one page of the one or more printed pages of the paper document such that at least one video frame of the one or more video frames that satisfies the selection criterion is annotated (see abstract & fig 8 & column 2, lines 23-42, including the explanation provided in the Independent claim).

It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references <u>should not be considered to be limiting in any way.</u> A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]

Response to Arguments

9.   Applicants arguments filed in the appeal brief dated 11/10/2008 are moot in view of the new grounds of rejection.

Conclusion

References Cited

10.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kenner et al. (U.S. 6,496,856) discloses "Video Storage And Retrieval System"

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M,F 8:30-6:00 T,TH 8:30-3:00 Wed 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571)272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel
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January 30, 2009

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